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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,675	07/09/2001	Nicholas Paul Elliott	UDL 2 0011	2251

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James W McKee
Fay Sharpe Fagan Minnich & McKee
Seventh Floor
1100 Superior Avenue
Cleveland, OH 44114-2518

EXAMINER

KLIMACH, PAULA W

ART UNIT PAPER NUMBER

2135

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,675

Applicant(s)

ELLIOTT ET AL.

Examiner

Paula W. Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is in response to amendment filed on 03/25/05. Original application contained Claims 1-14. Applicant amended Claims 1-14. The amendment filed on 03/25/05 have been entered and made of record. Therefore, presently pending claims are 1-14.

Response to Arguments

Applicant's arguments filed 03/25/05 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that the data of the current invention can be equated with the serial number in Coppersmith...the terms public data and private data have been amended to public plain text and private plain text. This is not found persuasive. Plain text is information that is not encrypted. The keys disclosed by Coppersmith are not encrypted and are therefore plain text. They are public if they are provided to the public and private if they are not provided to the public.

Applicant argues further that claim 1 requires both public and private plain text in both instances which makes it a secure process, whereas the method of Coppersmith only relate to use of private keys for producing encrypted security codes and the use of public keys for the verification process. This is not found persuasive. The public and private key of Coppersmith work as a pair (column 2 lines 57-67) therefore to verify the encryption the public key the private key must be a matching pair by the definition of public/private key encryption.

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The applicant argues further that the feature of the list of verification codes recited in amended claim 1 is more than a convenient method of organizing the verification codes; it is indicative of the fundamental difference between the method of claim 1 and the method of Coppersmith. In response to this argument the examiner has new grounds of rejection including Nagata that stores a list of transaction codes including codes representing transaction numbers that are maintain in a table (list).

The new grounds of rejection are presented below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite “Goods marked for verification...” the claims are broad enough to read on printed matter with a verification mark (such as digital signature).

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

are
Claims 7 and 11 rejected under 35 U.S.C. 102(e) as being anticipated by Coppersmith.

Coppersmith discloses a system for protection of goods against counterfeiting (title), characterized in that a security code is applied to the goods (column 4 lines 8-10) the public key (public plain text) is made available on the product itself; therefore applied to the goods (column 2 lines 65-67). The security code having been derived by means of a predetermined encryption algorithm from the public keys (public text) applied to the goods and plurality of (private text) private key sets held by verifier (column 2 lines 42-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coppersmith et al (6,069,955) in view of Nagata (Re, 32, 985).

In reference to claims 1, Coppersmith discloses a system for protection of goods against counterfeiting (title), and therefore a system for verifying the authenticity of goods.

Coppersmith discloses a system and method that comprises a security code is applied to the

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goods (column 4 lines 8-10), said security code having been derived by means of a predetermined encryption algorithm from said public data applied to the goods and a plurality of private data sets held by a verifier (column 2 lines 42-67); and, upon receiving a request for verification, each private data set is entered into said predetermined encryption algorithm together with the public data applied to the goods, the verification codes is compared with the security code applied to the goods to assess the authenticity of goods (column 2 lines 57-67 and column 3 lines 31-58).

Although Coppersmith discloses that the manufacturer possessing the private keys and corresponding public keys and therefore verification codes (column 3 lines 35-36), Coppersmith does not expressly disclose organizing these verification codes in a list of verification codes.

Nagata discloses a credit transaction processing system process data related to a commodity entered into by using a card (abstract). The codes are used as identification (column 4 line 52 to column 5 line 13).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to generate a list of verification codes for finding the authenticity in the system of Coppersmith. One of ordinary skill in the art would have been motivated to do this because a list is a convenient method of organizing the security codes and identifying commodities.

In reference to claims 3, 8 and 12, wherein the public plain text includes a batch number. Coppersmith indicates that the product could be a container of items, and therefore a batch (column 2 lines 44-45).

In reference to claims 4, 9, and 13, wherein the public plain text includes date information (column 4 lines 26-27).

In reference to claim 5, wherein the private plain text includes an item number (column 4 lines 26-27).

In reference to claims 6, 10, and 14, wherein said public plain text and said security code is incorporated into the design printed onto the goods as reversed out characters, blends or tints (column 4 lines 19-22 and lines 58-59).

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coppersmith and Nagata as applied to claim 1 above, and further in view of Tran (5,864,665).

Coppersmith does not disclose a system wherein the verifier maintains a log of requests for verification and, upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

Tran discloses a method of auditing login activity (abstract), where login activity is used to verify that users are who they say they are, by maintaining a record of valid login (column 7 lines 54-60 and column 8 lines 44-47). This information may generally used for verification upon receiving a request for verification, compares the public data applied to the goods with the data held in the log to assess the authenticity of goods.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to maintain a log of verification requests as in Tran in the system of Coppersmith. One of ordinary skill in the art would have been motivated to do this because the log would provide a record of the goods needing verification.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W. Klimach whose telephone number is (571) 272-3854. The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PWK

Wednesday, June 01, 2005



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100